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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/782,718 | 02/13/2001 | Steven P. Hamilton | 15879-13 | 1023 |

7590 12/18/2002

Squire, Sanders & Dempsey, L.L.P.
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EXAMINER

BRATLIE, STEVEN A

ART UNIT

PAPER NUMBER

3652

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | | | |
|-----------------|---------|----------------|----------|
| Application No. | 782718 | Applicant(s) | HAMILTON |
| Examiner | BRATLIE | Group Art Unit | 3652 |

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--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

Responsive to communication(s) filed on 11/13/02

This action is FINAL.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

Claim(s) 1-45, 48-53 is/are pending in the application.

Of the above claim(s) 2, 3, 4-17, 19-26, 23-44, 53 is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1, 4, 18, 23, 45, 48-52 is/are rejected.

Claim(s) _____ is/are objected to.

Claim(s) _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on _____ is approved disapproved.

The drawing(s) filed on 11/13/02 is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ Interview Summary, PTO-413

Notice of References Cited, PTO-892 Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948 Other _____

Office Action Summary

1. Applicant's arguments filed November 13, 2002 have been fully considered but they are not deemed to be persuasive. Applicant's discussion of certain individual features of the several references is insufficient to show unobviousness where the rejection is based on a combination of the references (In re Young et al, 159 USPQ 725).

It is within the purview of 35 U.S.C. 103 to select features from the prior art to effect results expected from these features (In re Skoner et al, 186 USPQ 80). Moreover, in evaluating such references, it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom (In re Preda 159 USPQ 342; In re Heldt 167 USPQ 676). The test for obviousness is not whether the feature of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art (In re Keller, 208 USPQ 871).

2. Determinations of obviousness take into account the collective teachings of the prior art and level of ordinary skill in the art. The claimed subject matter takes into account only knowledge which a person having ordinary skill in this art would find obvious with the references relied upon by the examiner (In re McLaughlin 170 USPQ 209). The issue of obviousness is not only determined by what the references expressly state but also is determined by what they would fairly suggest to those of ordinary skill in the art (In re Delisle 160 USPQ 806; In re Bozek 163 USPQ 545). It is noted that skill, not the converse, is presumed on the part of those practicing in the art

(*In re Sovish* 226 USPQ 771) and the conclusion of obviousness can be made from "common sense" of the person of ordinary skill in the art (*In re Bozek* 163 USPQ 545). Since the claimed subject matter would have been obvious from the references, it is immaterial that the references do not state the problem or advantage ascribed by applicant (*In re Wiseman* 201 USPQ 658).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1, 4, 18, 22, 45, 48-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matovich in view of British Patent #2326632, Siebert, and Scott. Matovich discloses a substantially similar transporter in Figures 6 and 7. It is noted that Matovich in col. 1 lines 34-40 and col. 7 lines 19-27 states that various number of units can be used to move loads of "any shape or size can be transported". It is apparent that a motorcycle can be transported using two units. Matovich lacks the specific type of actuator to lift the transporter. British Patent #2326632 Figs. 2, 4 and Siebert

elements #64, #122 disclose the use of plural arms to raise the motorcycle. It would have been obvious to a mechanic with ordinary skill in the art at the time the invention was made to substitute such an actuator. The motivation is known substitution of equivalents. Scott discloses loading a transporter on a truck.

6. This application contains claims 2, 3, 4-17, 19-21, 23-44, 53 drawn to an invention nonelected with traverse in Paper No. 11. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

7. The drawings are objected to because applicants drawing sheets are labeled 1/19 etc. Only 14 sheets of drawing were submitted. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Bratlie whose telephone number is (703) 308-2669. The examiner can normally be reached on Monday through Thursday from 6:30 to 5:00.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-4177.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Bratlie/kl
December 17, 2002



STEVEN A. BRATLIE
PRIMARY EXAMINER